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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,705	09/18/2003	C. Anthony Altar	03235/100M087-US2	5502

7278 7590 07/26/2005

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EXAMINER

STANDLEY, STEVEN H

ART UNIT	PAPER NUMBER
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1649

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/664,705	ALTAR ET AL.	
	Examiner	Art Unit	
	Steven H. Standley	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to a method of identifying a compound to treat a neuropsychiatric disorder, classified in class 435, subclass 7.21.
  - II. Claims 8-15, drawn to a method of selecting a signature gene, classified in class 435, subclass 6.
  - III. Claims 16-29, drawn to a kit for detecting expression of signature genes, classified in class 536, subclass 23.1.

Although there are no provisions under the section for "Relationship of Inventions" in the M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute distinct inventions for the following reasons: Groups I and II are directed to methods that are distinct both physically and functionally, and are not required one for the other. Invention group I is a method of identifying a compound to treat neuropsychiatric disorders, whereas invention group II is a method of identifying genes that are differentially expressed with electroconvulsive seizures compared to control, which is physically and functionally distinct from group I. The methods have different goals and steps, and use different materials. Therefore a search and examination of the methods of group I and group II would constitute an undue burden, since the searches

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are entirely different and not coextensive, the classifications are different and the subject matter divergent.

Inventions I and II, and III are each related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the processes for using the kit can be practiced with a materially different kit. For instance, both methods could be practiced with labeled antibodies to the proteins encoded for by the nucleic acid signature genes, instead of using oligonucleotide probes.

### ***Election of Species***

Regardless of which of the above inventions is elected, further restriction is required under 35 U.S.C. 121:

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A. One specific sequence with SEQ ID NO:, i.e. select one sequence from SEQ ID NO:1 to 154 must be elected.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Each of SEQ ID NOs is a unique and separately patentable sequence, requiring a unique search of the prior art. Searching all of the sequences in a single patent application would constitute an undue search burden on the examiner and the USPTO's resources because of the non-coextensive nature of these searches.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In order to be fully responsive, Applicant must elect one from Groups I - III, and one from Group A to be examined even though the requirement is traversed. Applicant is advised that neither I - IX nor A are species election requirements; rather, each of I - III, and A is a restriction requirement.

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***Advisory Information***

In order to be compliant with the restriction requirement, applicant must elect one group in response to the restriction, and make an appropriate election of species based on that election.

Any inquiry concerning this communication should be directed toward examiner Steven Standley (Ph: 571-272-3432), or his supervisor Janet Andres (571-272-0867). The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (toll free) 866-217-9197.

Steve Standley, Ph.D.

June 28, 2005



LORRAINE SPECTOR  
PRIMARY EXAMINER